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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,698	08/30/2001	Satoshi Nagano	503.40569X00	6215
24956	7590	08/18/2005	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			ALVAREZ, RAQUEL	
		ART UNIT		PAPER NUMBER
				3622

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/941,698	NAGANO ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
Raquel Alvarez	3622		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 March 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to communication filed on 3/14/2005.
2. Claims 1-31 are presented for examination.

#### Claim Objections

3. Claims 5, 8, 13, 19 and 22 are objected to under 37 CFR 1.75(c) as being in improper form because multiple dependent claim may refer in the alternative to only one set of claims. See MPEP § 608.01(n).

#### Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5. Claims 1-4, 8, 13, 16-18, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. 5,848,397 hereinafter Marsh.

With respect to claims 1-4, 13, 16-18 Marsh teaches a method for providing advertisement information (Abstract). A step of storing advertisement information provided by a commercial sponsor into an advertisement storage means (Figure 8); a step of reading out advertisement information from said advertisement storage means (Figure 8); a step of sending said advertisement information, read out from said advertisement storage means, via an information transmission line (Figure 8, 104); a step of receiving via said information transmission line or a different transmission line, information on a viewing history information representing a history of paying said

advertisement information by said broadcasting terminal (Figure 8 and col. 15, lines 14-20); a step of using said viewing history information to calculate a charge for providing said advertisement information to be paid by said commercial sponsor (Col. 4, lines 30-40).

With respect to claims 8, 22 Marsh further teaches using said viewing history to determine a point to be supplied to the receiver terminal (i.e. based on the viewing history of the user, the information is used to target ads based on the user characteristics)(col. 15, lines 41-53).

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-7, 9-12, 14-15, 19-21, 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh in view of Official Notice.

Claims 5-7, 19-21 further recite a merit charge discount rate for the rental charge or lease charge of said broadcasting receiver terminal. Marsh teaches based on the

Art Unit: 3622

user's viewing ads subsidizing their Internet charges. Marsh doesn't teach that the discount is for the rental charges or lease charges of the terminal. Giving discounts as a form of subsidizing rental charges or lease charges is old and well known marketing techniques to motivate the customer to perform certain action. It would have been obvious to a person of ordinary skill in the art the time of Applicant's invention to have included a merit charge discount rate for the rental charge or lease charge of said broadcasting receiver terminal in order to obtain the above mentioned advantage.

With respect to claims 9-10, Marsh further teaches that the broadcast receiver terminal specified in advance and is provided with individual information (col. 16, lines 13-18).

With respect to claim 11, Marsh further teaches supplying the user statistical information to said commercial sponsor (see Figure 8 and col. 15, lines 14-20).

With respect to claims 12, 14 Marsh further teaches that the information is information on any of age, sex and residential area (col. 15, lines 31-53).

With respect to claim 15, Marsh teaches a method for providing advertisement information (Abstract). A step of sending advertisement information via an information transmission line (see Figure 8); a step of receiving, via said information transmission line or different transmission line, viewing history information stored in a broadcasting

receiving terminal, said viewing history information representing a history of playing said advertisement information by said broadcasting receiving terminal (Figure 8 and col. 15, lines 14-20); a step of using said viewing history information and play conditions determined in connection with said broadcasting terminal to determine if said play conditions have been satisfied (i.e. the system determines if the user has viewed the corresponding ads to receive free of charge services)(col. 3, 2-4).

With respect to calculating a charge if said play conditions have not be satisfied. Since Marsh teaches determining if the user has viewed the corresponding ads to receive free of charge service on col. 2, lines 2-4) then it would have been obvious to a person of ordinary skill to have calculated a charge if the user doesn't view all the ads to satisfy the condition for the free service.

With respect to claims 23-24, Marsh further teaches that the broadcast receiver terminal specified in advance and is provided with individual information (col. 16, lines 13-18).

With respect to claim 25, Marsh further teaches supplying the user statistical information to said commercial sponsor (see Figure 8 and col. 15, lines 14-20).

Claims 26-29 further recite that the information is received by a radio wave via satellite or terrestrial radio wave. Official notice is taken that it is old and well known to

use radio wave via satellite or terrestrial radio wave for communication between satellites. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the use of radio wave via satellite or terrestrial radio wave in order to obtain the above mentioned advantage.

With respect to claim 30, Marsh further teaches wherein said advertisement information is played at a time of conditional access of said program information by said broadcasting receiver terminal (col. 3, lines 57 to col. 4, lines 1-17).

With respect to claim 31, Marsh further teaches wherein said advertisement information past a term of validity is deleted (col. 13, lines 19-25).

**Response to Arguments**

8. Applicant makes note of an Information Disclosure Statement (IDS) submitted on 8/30/2001 and re-submitted on 3/14/2005 along with the amendment. The amendment submitted on 3/14/2005 contained amendments to the claims on pages 2-10 and Remarks on pages 12-17 but no record of an IDS.

9. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

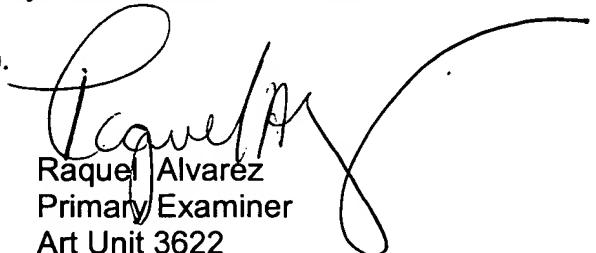
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of contact**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
8/11/2005